

42390.P8786X

PATENT

#5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Jim B. Estipona

Serial No.: 09/823,513

Filed: March 30, 2001

For: METHOD AND APPARATUS TO
CONFIGURE VIDEO OPERATION

Examiner: Unassigned

Art Unit: 2151

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BOX MISSING PARTS

Assistant Commissioner for Patents
Washington, D.C. 20231

**OFFICE OF PETITIONS
DEPUTY A/C PATENTS**

PETITION UNDER 37 CFR § 1.47(b)

Sir:

Pursuant to 37 C.F.R. § 1.47(b), Applicants hereby request that Intel Corporation be allowed to continue the above-identified patent application in the name of refusing sole inventor, Jim B. Estipona. Facts in support of this petition are set forth below, and pertinent information is attached thereto.

(1) Jim B. Estipona is named as the sole inventor in the above-identified patent application and refuses to sign the Oath/Declaration required by C.F.R. § 1.63.

(2) Attached hereto is the Declaration of Charles A. Mirho, the prosecuting attorney of record, setting out the pertinent facts regarding the refusal of Jim B. Estipona to sign the Inventor Declaration and Power of Attorney for the above-referenced patent application.

(3) Attached hereto is the Inventor Declaration and Power of Attorney on behalf of non-signing inventor, Jim B. Estipona.

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130.00 OP

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PATENT

(4) Attached hereto is the relevant portion of the employment contract between inventor Jim B. Estipona and Intel Corporation in which inventor Jim B. Estipona agreed to assign the above-referenced patent application to Intel Corporation.

(5) Because the signature of inventor Jim B. Estipona on the Inventor Declaration is required to file a complete patent application with the United States Patent and Trademark Office, and inventor Jim B. Estipona refuses to sign the required Inventor Declaration, Intel Corporation may lose its rights to file the above-reference patent application should a petition under 37 C.F.R. § 1.47(b) not be granted, therefore, grant of this petition is necessary to preserve the rights of the parties.

(3) The last known address for sole inventor Jim B. Estipona is:

905 S.W. Cedar Hills
1327
Portland, OR 97225

In view of this petition and the attached documents, Applicants request that prosecution be allowed to proceed.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 7-30-01

Charles A. Mirho
Charles A. Mirho (Reg. No. 41,199)

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1026
(408) 720-8300

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner of Patents, Washington, D.C. 20231 on:

July 31, 2001

Date of Deposit

DEBORAH L. HIGMAN

Name of Person Mailing Correspondence

JOHN Q. [Signature]
Signature

7/31/01
Date



042390.P8786X

PATENT

#3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Jim B. Estipona

Serial No.: 09/823,513

Filed: March 30, 2001

For: METHOD AND APPARATUS TO
CONFIGURE VIDEO OPERATION

Examiner: Unassigned

Art Unit: 2151

BOX MISSING PARTS

Assistant Commissioner for Patents
Washington, D.C. 20231

DECLARATION OF CHARLES A. MIRHO

Dear Sir:

I, Charles A. Mirho, having personal knowledge of the facts set forth herein, hereby declare as follows:

1. I am the Attorney of Record for the above-identified patent application entitled "METHOD AND APPARATUS TO CONFIGURE VIDEO OPERATION"
2. The above-identified patent application names the inventor as Jim B. Estipona.
3. The above-identified patent application was filed with an un-signed Inventor Declaration and Power of Attorney form with the U.S. Patent Office on March 30, 2001.
4. On May 24, 2001, I received a "Notice to File Missing Parts of Nonprovisional Application (Filing Date Granted) with a mailing date of May 17, 2001.
5. On July 18, 2001, via an electronic mail communication, Jim B. Estipona refused to sign the Inventor Declaration and Power of Attorney.

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PATENT

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with knowledge that willful, false statements and the like may jeopardize the validity of the application, or any patent resulting therefrom.

Respectfully submitted,

Date: 7-30-01Charles A. Mirho
Charles A. Mirho (Reg. No. 41,199)

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300

CERTIFICATE OF FIRST CLASS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to BOX MISSING PARTS, Assistant Commissioner for Patents, Washington, D.C. 20231 on July 31, 2001.

Deborah L. Higham

Name of Person Mailing Correspondence

Deborah L. Higham

Signature of Person Mailing Correspondence

7/31/01
Date



Intel Corporation
ES Record Retrieval
3740 West 13400 South
RV1-479
Riverton, UT 84065
Tel: 801-445-2181
Fax: 801-445-0176

Date: July 30, 2001
Pages: 2
To: Trisha Daley
Fax Number: 8-765-3728
From: Cameron Anderson
ES Record Retrieval

Message:

☐ Urgent ☒ Confidential ☐ Please Comment ☐ Please Reply

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"THIS INFORMATION IS INTENDED TO BE FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ON THIS TRANSMITTAL SHEET. IF YOU ARE NOT THE INTENDED RECIPIENT, BE AWARE THAT ANY DISCLOSURE, COPYING, DISTRIBUTION OR USE OF THE CONTENTS OF THIS FAXED INFORMATION IS PROHIBITED. IF YOU HAVE RECEIVED THIS FACSIMILE IN ERROR, PLEASE NOTIFY THE SENDER BY TELEPHONE IMMEDIATELY SO THAT ARRANGEMENTS CAN BE MADE FOR THE RETRIEVAL OF THE ORIGINAL DOCUMENT AT NO COST TO YOU."

Employee Agreement

In exchange for being employed by Intel Corporation, its subsidiaries, affiliates, or successors (herein "Intel"), I agree that:

1. **General Conduct** While working for Intel, I will perform my assigned duties and comply with all Intel policies, procedures, guide lines, rules and instructions, including Intel's Corporate Business Principles.
2. **Prior Third Party Information** I represent that I do not possess, have not brought, and will not bring to Intel, nor use in the course of the performance of my duties at Intel, any proprietary or confidential information of any former employer or third party without their written authorization.
3. **Confidential Information** At all times, both during and after my employment with Intel, I will not use (except for the benefit of Intel at Intel's direction) and will hold in confidence and not disclose (without Intel's written authorization) any proprietary or trade secret information (technical or otherwise) of Intel or any third party, until such information becomes generally and rightfully known outside Intel without nondisclosure restriction, or for the maximum period of time for maintaining trade secrets as permitted by law in the state in which I am employed if such period is shorter. I agree not to make unauthorized copies of such confidential information and to return to Intel immediately upon my termination or upon Intel's request, all tangible forms of such confidential information, including but not limited to drawings, computerized data or programs, specifications, documents, devices, models, employee lists or phone books, or any other Intel confidential information. I will, at all times, treat third parties' confidential information, to which I have access during my employment by Intel, according to the terms of any agreement between Intel and the third parties regarding such third party confidential information.
4. **Intellectual Property** During my employment with Intel I will, without additional compensation, promptly disclose and, to the full extent allowed by law, assign to Intel all rights to which I may be entitled with respect to patents, trade secrets, copyrights, mask works, trademarks, inventions, discoveries, designs, formulae, processes, methods, manufacturing techniques, improvements, ideas, copyrightable works and other intellectual property: (a) which relate to Intel's past, present, or demonstrated or reasonably foreseeable future business or research, whether or not developed during normal working hours; or (b) which are developed with the use or aid of any Intel equipment, supplies, or facilities; or (c) which use or are based on or developed from any proprietary or confidential information of Intel, or of a third party, access to which I obtain through Intel or in the course of my duties at Intel. At all times, both during and after my Intel employment, I will do whatever is reasonably requested by Intel, at Intel's expense, to assist Intel in obtaining and enforcing Intel's rights throughout the world with respect to the assignments which I have made or am obligated to make to Intel under this Agreement.

As to any intellectual property rights, whether vested or pending, which I own or control in whole or in part, either prior to joining Intel or at any time during my employment with Intel, I grant Intel a nonexclusive, nontransferable, perpetual, irrevocable, royalty-free, worldwide license, with the right to sublicense, to make, have made, use, sell, offer to sell, import, reproduce, have reproduced, prepare derivative works of, distribute and otherwise dispose of any product or document, except that I do not grant any license to any item of intellectual property which is identified by me in Appendix A at the time of execution of this Agreement and such Appendix A is submitted directly by me to Intel Legal and actually received by Intel Legal within five working days of my hiring.

As to any intellectual property identified in Appendix A, and as to any intellectual property which I acquire or control during my Intel employment and which is not assigned or licensed to Intel, I agree that: (A) I will (i) notify Intel Legal of any change in status, within five working days of such change, such as my acquisition of a new intellectual property right, or such as a patent application becoming an issued patent, (ii) notify Intel Legal promptly upon learning or reasonably suspecting that any Intel product includes, or is proposed to include, such intellectual property, (iii) not cause any Intel product to infringe such intellectual property, and (iv) not use my Intel employment to in any way disadvantage Intel with regard to any such intellectual property; or (B) I grant Intel a license as described above. No such license grant shall limit other remedies otherwise available to Intel.

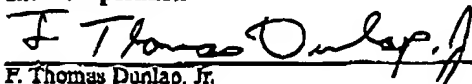
If I fail to make any required disclosure or breach any term of this paragraph 4, I agree that the statute of limitations shall be tolled as to any claim, right or cause of action Intel may have against me relating to such disclosure or breach that Intel would have discovered had the required disclosure been made, until such time as Intel obtains actual knowledge of the facts giving rise to its claim.

5. **Miscellaneous** I understand and agree that my employment with Intel is "at will." This means that both Intel and I have the right to terminate my employment at any time, with or without advance notice and with or without cause. This Agreement: (a) survives my employment by Intel, (b) insures to the benefit of successors and assigns of Intel, and (c) is binding upon my heirs, assigns and legal representatives. To the best of my information and belief, I am not a party to any other agreement which will interfere with my full compliance with this Agreement, except as specifically identified herein:


This Agreement may not be modified or amended except in a writing signed by the parties.

I certify and acknowledge that I have carefully read all of the provisions of this Agreement and that I understand and will fully and faithfully comply with such provisions.

Intel Corporation

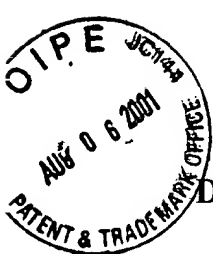

F. Thomas Dunlap, Jr.
Vice President, General Counsel, and Secretary

Employee


Signature
JIM ESTIPONA
Printed Name (please print clearly)

3-23-98
Date

434-75-2850
Social Security Number

**DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION
(FOR INTEL CORPORATION PATENT APPLICATIONS)**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below, next to my name.

I believe I am the original, first, and sole inventor (if only one name is listed below) or an original, first, and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

METHOD AND APPARATUS TO CONFIGURE VIDEO OPERATION

the specification of which

☐
☒

is attached hereto.

was filed on March 30, 2001 as

United States Application Number 09/823,513

or PCT International Application Number _____

and was amended on _____

(if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claim(s), as amended by any amendment referred to above. I do not know and do not believe that the claimed invention was ever known or used in the United States of America before my invention thereof, or patented or described in any printed publication in any country before my invention thereof or more than one year prior to this application, that the same was not in public use or on sale in the United States of America more than one year prior to this application, and that the invention has not been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months (for a utility patent application) or six months (for a design patent application) prior to this application.

I acknowledge the duty to disclose all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d), of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s):

APPLICATION NUMBER	COUNTRY (OR INDICATE IF PCT)	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 37 USC 119
			<input type="checkbox"/> No <input type="checkbox"/> Yes
			<input type="checkbox"/> No <input type="checkbox"/> Yes
			<input type="checkbox"/> No <input type="checkbox"/> Yes

I hereby claim the benefit under Title 35, United States Code, Section 119(e) of any United States provisional application(s) listed below:

APPLICATION NUMBER	FILING DATE

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

APPLICATION NUMBER	FILING DATE	STATUS (ISSUED, PENDING, ABANDONED)
09/633,454	8/7/2000	pending

I hereby appoint the persons listed on Appendix A hereto (which is incorporated by reference and a part of this document) as my respective patent attorneys and patent agents, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith.

Send correspondence to:

Charles A. Mirho, Reg. No. 41,199, BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

(Name of Attorney or Agent)

12400 Wilshire Boulevard, 7th Floor, Los Angeles, California 90025 and direct telephone calls to:

Charles A. Mirho, (503) 684-6200.

(Name of Attorney or Agent)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Sole/First Inventor (given name, family name)

Jim B. Estipona

Inventor's Signature _____

Date _____

Residence Portland, Oregon USA
(City, State)

Citizenship Philippines
(Country)

Mailing Address 905 S.W. Cedar Hills, #1327

Portland, Oregon 97225 USA

Full Name of Second/Joint Inventor (given name, family name) _____

Inventor's Signature _____

Date _____

Residence _____
(City, State)

Citizenship _____
(Country)

Mailing Address _____

Full Name of Third/Joint Inventor (given name, family name) _____

Inventor's Signature _____

Date _____

Residence _____
(City, State)

Citizenship _____
(Country)

Mailing Address _____

Full Name of Fourth/Joint Inventor (given name, family name) _____

Inventor's Signature _____

Date _____

Residence _____
(City, State)

Citizenship _____
(Country)

Mailing Address _____

Full Name of Fifth/Joint Inventor (given name, family name) _____

Inventor's Signature _____

Date _____

Residence _____
(City, State)

Citizenship _____
(Country)

Mailing Address _____

Full Name of Sixth/Joint Inventor (given name, family name) _____

Inventor's Signature _____

Date _____

Residence _____
(City, State)

Citizenship _____
(Country)

Mailing Address _____

Full Name of Seventh/Joint Inventor (given name, family name) _____

Inventor's Signature _____

Date _____

Residence _____
(City, State)

Citizenship _____
(Country)

Mailing Address _____

Full Name of Eighth/Joint Inventor (given name, family name) _____

Inventor's Signature _____

Date _____

Residence _____
(City, State)

Citizenship _____
(Country)

Mailing Address _____

Full Name of Ninth/Joint Inventor (given name, family name) _____

Inventor's Signature _____

Date _____

Residence _____
(City, State)

Citizenship _____
(Country)

Mailing Address _____

Full Name of Tenth/Joint Inventor (given name, family name) _____

Inventor's Signature _____

Date _____

Residence _____
(City, State)

Citizenship _____
(Country)

P. O. Address _____

Full Name of Eleventh/Joint Inventor (given name, family name) _____

Inventor's Signature _____

Date _____

Residence _____
(City, State)

Citizenship _____
(Country)

Mailing Address _____

APPENDIX A

William E. Alford, Reg. No. 37,764; Farzad E. Amini, Reg. No. 42,261; William Thomas Babbitt, Reg. No. 39,591; Carol F. Barry, Reg. No. 41,600; Jordan Michael Becker, Reg. No. 39,602; Lisa N. Benado, Reg. No. 39,995; Bradley J. Berezna, Reg. No. 33,474; Michael A. Bernadieu, Reg. No. 35,934; Roger W. Blakely, Jr., Reg. No. 25,831; R. Alan Burnett, Reg. No. 46,149; Gregory D. Caldwell, Reg. No. 39,926; Andrew C. Chen, Reg. No. 43,544; Thomas M. Coester, Reg. No. 39,637; Donna Jo Coningsby, Reg. No. 41,684; Florin Corie, Reg. No. 46,244; Dennis M. deGuzman, Reg. No. 41,702; Stephen M. De Klerk, Reg. No. P46,503; Michael Anthony DeSanctis, Reg. No. 39,957; Daniel M. De Vos, Reg. No. 37,813; Justin M. Dillon, Reg. No. 42,486; Sanjeet Dutta, Reg. No. P46,145; Matthew C. Fagan, Reg. No. 37,542; Tarek N. Fahmi, Reg. No. 41,402; Mark W. Farrell, Reg. No. 45,988; George Fountain, Reg. No. 37,374; James Y. Go, Reg. No. 40,621; James A. Henry, Reg. No. 41,064; Willmore F. Holbrow III, Reg. No. P41,845; Sheryl Sue Holloway, Reg. No. 37,850; George W. Hoover II, Reg. No. 32,992; Eric S. Hyman, Reg. No. 30,139; William W. Kidd, Reg. No. 31,772; Sang Hui Kim, Reg. No. 40,450; Walter T. Kim, Reg. No. 42,731; Eric T. King, Reg. No. 44,188; George B. Leavell, Reg. No. 45,436; Kurt P. Leyendecker, Reg. No. 42,799; Gordon R. Lindeen III, Reg. No. 33,192; Jan Carol Little, Reg. No. 41,181; Robert G. Litts, Reg. No. 46,876; Julio Loza, Reg. No. 47,758; Joseph Lutz, Reg. No. 43,765; Michael J. Mallie, Reg. No. 36,591; Andre L. Marais, under 37 C.F.R. § 10.9(b); Paul A. Mendonsa, Reg. No. 42,879; Clive D. Menezes, Reg. No. 45,493; Chun M. Ng, Reg. No. 36,878; Thien T. Nguyen, Reg. No. 43,835; Thanh V. Nguyen, Reg. No. 42,034; Dennis A. Nicholls, Reg. No. 42,036; Daniel E. Ovanezian, Reg. No. 41,236; Kenneth B. Paley, Reg. No. 38,989; Gregg A. Peacock, Reg. No. 45,001; Marina Portnova, Reg. No. P45,750; Michael A. Proksch, Reg. No. 43,021; William F. Ryann, Reg. No. 44,313; James H. Salter, Reg. No. 35,668; William W. Schaal, Reg. No. 39,018; James C. Scheller, Reg. No. 31,195; Jeffrey S. Schubert, Reg. No. 43,098; George Simion, Reg. No. P47,089; Maria McCormack Sobrino, Reg. No. 31,639; Stanley W. Sokoloff, Reg. No. 25,128; Edwin H. Taylor, Reg. No. 25,129; Lance A. Termes, Reg. No. 43,184; John F. Travis, Reg. No. 43,203; Joseph A. Twarowski, Reg. No. 42,191; Kerry D. Tweet, Reg. No. 45,959; Mark C. Van Ness, Reg. No. 39,865; Thomas A. Van Zandt, Reg. No. 43,219; Lester J. Vincent, Reg. No. 31,460; Glenn E. Von Tersch, Reg. No. 41,364; John Patrick Ward, Reg. No. 40,216; Mark L. Watson, Reg. No. P46,322; Thomas C. Webster, Reg. No. P46,154; and Norman Zafman, Reg. No. 26,250; my patent attorneys, and Firasat Ali, Reg. No. 45,715; Richard Nakashima, Reg. No. 42,023, my patent agents of BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP, with offices located at 12400 Wilshire Boulevard, 7th Floor, Los Angeles, California 90025, telephone (310) 207-3800, and Alan K. Aldous, Reg. No. 31,905; Ben Burge, Reg. No. 42,372; Robert A. Burtzlaff, Reg. No. 35,466; Richard C. Calderwood, Reg. No. 35,468; Jeffrey S. Draeger, Reg. No. 41,000; Cynthia Thomas Faatz, Reg. No. 39,973; Jeffrey B. Huter, Reg. No. 41,086; John Kacvinsky, Reg. No. 40,040; Seth Z. Kalson, Reg. No. 40,670; David J. Kaplan, Reg. No. 41,105; Peter Lam, Reg. No. 44,855; Charles A. Mirho, Reg. No. 41,199; Paul Nagy, Reg. No. 37,896; Leo V. Novakoski, Reg. No. 37,198; Thomas C. Reynolds, Reg. No. 32,488; Kenneth M. Seddon, Reg. No. 43,105; Mark Seeley, Reg. No. 32,299; Steven P. Skabrat, Reg. No. 36,279; Howard A. Skaist, Reg. No. 36,008; Robert G. Winkle, Reg. No. 37,474; Sharon Wong, Reg. No. 37,760; Steven D. Yates, Reg. No. 42,242; Calvin E. Wells; Reg. No. 43,256 and Charles K. Young, Reg. No. 39,435; my patent attorneys, and my patent agents, of INTEL CORPORATION; and James R. Thein, Reg. No. 31,710, my patent attorney; with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith.